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Patent Applicant: Huff *et al.*)
Confirmation No.: 9783)
Serial No.: 10/749,281)
Filed: December 30, 2003) Group Art Unit: 2837
For: Bumper Muffler Assembly) Examiner: E. San Martin

Commissioner for Patents
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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Sirs:

This is a Pre-Appeal Brief Request for Review of the final rejections made in the Office Action mailed on June 14, 2007 and is submitted concurrently with a Notice of Appeal and requisite fees. Upon carefully considering the following comments and the arguments of record (all of which are incorporated herein by reference in their entireties), it is believed that the panel will agree that the Examiner has acted arbitrarily in making the extant obviousness rejections without the requisite substantive evidence.

The claims at issue include claims 1-17 and 19-43 (claim 18 being canceled), of which claims 1, 16, 22 and 32 are independent.

The Examiner has rejected claims 1-11 and 32-43 under 35 U.S.C. §103(a) in view of U.S. Patent No. 4,993,513 to Inoue *et al.* ("the '513 Patent") in combination with U.S. Patent No. 5,955,707 to Fritz ("the '707 Patent"). The Examiner has also rejected claims 12-17 and 19-31 under 35 U.S.C. §103(a) in view of the '513 Patent in combination with the '707 Patent and U.S. Patent No. 5,726,398 to Zahn ("the '398 Patent"). In the Office action dated March 28, 2007, the Examiner states "it would have been an obvious design choice to employ

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a multilayer bushing because depending on the application, different suitable materials and configuration would be needed as to sustained various environmental characteristics . . . the Examiner considers that any person with ordinary skill in the art would employ a specific bushing configuration depending upon the application constraints and desired results.” Applicants respectfully submit that the Examiner fails to provide *prima facie* case of obviousness.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. *In re Vaack*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). (See also, *Manual of Patent Examining Procedure* (M.P.E.P.)§2143 Basic Requirements of a Prima Facie Case of Obviousness).

Applicants submit that the Examiner has failed to establish that the prior art references teach or suggest the use of a multilayer bushing of independent claims 1, 16, 22 and 32. Further, Applicants submit that the Examiner has failed to show a reasonable expectation of success and has only alleged that there is some motivation to modify the base references. Applicants submit that the Examiner's reliance on *In re Leshin* to supply this apparent deficiency in the prior art is inappropriate. In *Leshin*, the material in question, plastic, was selected for use in the claimed device based on its known suitability for the applicant's intended purpose. The Examiner has extended the reasoning in *Leshin* to seemingly cover the substitution of any known material for another, which is clearly not provided for by *Leshin*. The multilayer bushing claimed, “provide[s] a snug, expandable fit to the muffler shell and provide gas tight properties to the bushing assembly.” Nowhere within the '513 Patent, the '707 Patent or the '398 Patent is such a multilayer bushing shown or suggested. Therefore, Applicants respectfully request that the rejection of claims 1, 16, 22 and 32 be reconsidered and withdrawn.

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In the Advisory Action, the Examiner introduces new art to the record stating "the Examiner considers that the patents to Farnam *et al.* (U.S. 3,941,690) Tucker *et al.* (U.S. 5,292,270), Li *et al.* (U.S. 5,480,706), Rafferty *et al.* (U.S. 5,656,376), Boss *et al.* (U.S. 6,465,110) and Halter (U.S. 4,045,057) [collectively "the Additional References"] are examples of references that teach the well known use of multilayer bushings (or vibration dampers), which have different layer's configurations depending upon the constraints of a particular application." Applicants submit that the Additional References do not cure the deficiencies of the underlying rejection as none of the references teach a heat dissipating and vibration damping multilayer bushing in combination with a muffler/exhaust pipe system or a bumper/muffler/exhaust system as claimed in the independent claims. In addition, the Examiner has given no reason why one of ordinary skill in the art would combine the Additional References with the '513 Patent, the '707 Patent or the '398 Patent. Nor has the Examiner shown any reason in the '513 Patent, the '707 Patent or the '398 Patent why one of ordinary skill would attempt to add any feature present in the Additional References to the teachings of the '513 Patent, the '707 Patent or the '398 Patent.

Applicants respectfully request, if the Office is to rely upon the Additional References that the Final Rejection be withdrawn and the Additional References be properly made of record.

Further, Applicants submit that the prior art reference (or references when combined), do not teach or suggest all of the claim limitations, nor do the references include any teaching or suggestion to make the claimed combination with a reasonable expectation of success. Applicants submit that the Examiner's rejection is instead based upon Applicants' disclosure, which is clearly prohibited by *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991) and the *Manual of Patent Examining Procedure* §2142. Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so. (See *In re Kahn*, 441 F.3d 977, 986, 78 USPQ2d 1329, 1335 (Fed. Cir. 2006)). Applicants submit that one of ordinary skill in the art simply would not be motivated to combine the cited references to derive the claimed muffler system. (See *In re Rouffet*, 149 F.3d 1350, 1357, 47 USPQ2d 1453, 1457-58

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(Fed. Cir. 1998) (The combination of the references taught every element of the claimed invention, however without a motivation to combine, a rejection based on a *prima facie* case of obvious was held improper.)). The Examiner has not shown any teaching in the '513 Patent, the '707 Patent, the '398 Patent or within any of the Additional References that would provide a motivation to combine the references to form the invention claimed by Applicants. Therefore, Applicants respectfully submit that the Office has failed to establish a *prima facie* case of obviousness. Consequently, Applicants respectfully submit that claims 1, 16, 22 and 32, and all claims dependent therefrom, are non-obvious and patentable.

In summary, Applicants firmly believe that the pending claims are patentably distinguishable over the prior art and should be formally allowed. Upon careful review and consideration, it is believed the panel will agree and instruct the Office to issue a Notice of Allowance. Any fees required in connection with this document may be debited to Deposit Account 50-0568.

Respectfully submitted,

Date:

July 13, 2007


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